

## Interview Summary

Application No.

09/315,796

Applicant(s)

Davis et al.

Examiner

Stephen R. Funk

Group Art Unit

2854

All participants (applicant, applicant's representative, PTO personnel):

(1) Stephen R. Funk(3) Ray Prince(2) Robert Falk(4) Bill DavisDate of Interview Jul 19, 2000Type: ☐ Telephonic ☒ Personal (copy is given to ☐ applicant ☒ applicant's representative).Exhibit shown or demonstration conducted: ☒ Yes ☐ No. If yes, brief description:Discussed perfecting options in sheet fed pressesAgreement ☐ was reached. ☒ was not reached.Claim(s) discussed: In general

Identification of prior art discussed:

DeMoore et al. (US 5,960,713)

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Applicant presented and discussed various options on how to overcome DeMoore including, in particular, that the DeMoore patent is derived from applicant, filing a 1.131 declaration, and the DeMoore patent is not properly supported by the parent application 08/435,798. Also discussed the specific language in parent patent (5,630,363) that indicates that the press is a perfecting press.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☐ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

  
STEPHEN R. FUNK  
PRIMARY EXAMINER

Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.

**Application of Charles A. MATHEWS.**

**Patent Appeal No. 8008.**

United States Court of Customs and Patent Appeals.

April 10, 1969.

Appeal from decision of Patent Office Board of Appeals, Serial No. 263,450, affirming examiner's rejection of claims 1-10, all of claims in application for patent level detector and switch used to control switching transistors through which load circuit might be connected to power source. The Court of Customs and Patent Appeals, Baldwin, J., held that disclosure of applicant's invention in patent previously obtained by another did not establish lack of novelty of applicant's claimed invention and did not preclude granting patent to applicant.

Reversed.

**[1] PATENTS ⇨ 45**

291k45

Disclosure of applicant's invention in prior patent issued to another did not establish lack of novelty of applicant's invention and did not preclude granting patent to applicant. 35 U.S.C.A. § 102(e); Patent Office Practice Rules, rule 131, 35 U.S.C.A. App.

**[2] PATENTS ⇨ 59**

291k59

Compliance with Patent Office Rule to effect that when claim of application is rejected on reference to domestic patents substantially showing but not claiming invention, affidavits traversing reference or objection may be received is not the only way of antedating or overcoming a reference. Patent Office Practice Rules, rule 132, 35 U.S.C.A. App.

**[3] PATENTS ⇨ 59**

291k59

To overcome reference cited to evidence lack of novelty, applicant was not required to comply with Patent Office Practice Rule to effect that when claim of application is rejected on reference to domestic patents substantially showing or describing but not claiming invention, affidavit traversing references may be received. 35 U.S.C.A. § 102(e); Patent Office Practice Rules, rule 131, 35 U.S.C.A. App.

**PATENTS ⇨ 328(2)**

291k328(2)

3,105,920. Cited.

**\*\*1393 \*1034** Albert S. Richardson, Jr., Philadelphia, Pa., for appellant.

Joseph Schimmel, Washington, D.C. (Joseph Nakamura, Washington, D.C., of counsel), for the Commissioner of Patents.

Before WORLEY, Chief Judge, and RICH, SMITH, ALMOND, and BALDWIN, judges.

BALDWIN, Judge.

This appeal is from the Patent Office Board of Appeals decision affirming the examiner's rejection of claims 1-10, all of the claims in appellant's application, [FN1] 'as anticipated by Dewey [FN2] under 35 USC 102(e).'

FN1. Serial No. 263,450, filed March 7, 1963, for 'Level Detector and Switch.'

FN2. U.S. Patent 3,105,920, issued October 1, 1963, on application serial No. 138,476, filed September 15, 1961, for 'Protective Device.'

The issue here is whether a rejection under 35 U.S.C. § 102(e) may be overcome by a Rule 132 [FN3] affidavit of the reference patentee averring that the relevant, unclaimed subject matter disclosed **\*\*1394** in his patent was not invented by the patentee but was first disclosed to him by the appellant, particularly in light of certain acknowledgments in the patent and in the instant application. Since the issue is essentially legal in nature, only so much of the technology of the instant invention and of the reference as is necessary to relate the facts will be discussed.

FN3. United States Patent Office Rules of Practice in Patent Cases state:

132. Affidavits traversing grounds of rejection. When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or lacking in utility, or frivolous or injurious to public health or morals, affidavits traversing these references or objections may be received.

(Cite as: 56 C.C.P.A. 1033, \*1034, 408 F.2d 1393, \*\*1394)

\*1035 On September 15, 1961, Dewey filed an application describing and claiming a time delay 'Protective Device' for an electric circuit. In discussing 'gating means 19,' Dewey's original application completely described the invention now claimed by Mathews, a co-worker of Dewey, and concluded that:

Those skilled in the art will understand that this same function could be accomplished by means other than the particular gating means 19 which has been illustrated by way of example, and such particulars form no part of my invention.

Thus, Dewey's patent, which issued on the aforementioned application, contains a full disclosure of the invention now claimed by Mathews together with the above-quoted statement and reference to a switch actuation technique which 'may also be used in lieu of the illustrated gating means 19 to perform the gating function.'

On March 7, 1963, before Dewey's patent was issued but almost 18 months after Dewey had filed, Mathews filed the instant application describing and claiming a 'Level Detector and Switch' which is used to control a switching transistor through which a load circuit may be connected to a power source. The application states that 'one illustration of a circuit embody the present invention is shown in a copending patent application S.N. 138, 476-Dewey' and that '(a) more specific embodiment of the load circuit 44 is disclosed in detail in the copending Dewey application.' Mathews' application and the Dewey patent are both assigned to the General Electric Company.

Using the Dewey patent as a reference, the examiner rejected all of Mathews' claims under 35 U.S.C. § 102(e). In response thereto, and under the provisions of Rule 132, Mathews submitted Dewey's affidavit, the pertinent passages of which read:

7. That he (Dewey), being the patentee of the aforementioned patent, did not conceive, make, or invent the specific circuit referred to in paragraph 6 above (Mathews' invention as described in Dewey) and did not know of it prior to the disclosure referred to in paragraph 8 below;

8. That the applicant Charles A. Mathews disclosed the circuit referred to in paragraph 6 above which circuit is the subject matter of the subject application, to him while a protective device embodying the

invention of the aforementioned patent was being developed;

9. That the circuit referred to in paragraph 6 was included in the specification of his patent to comply with the requirements of 35 U.S.C. 112, under the advice of General Electric Patent Attorneys;

10. That he did not, in his application which matured into Patent 3,105,920, nor does he now claim the circuit referred to in paragraph 8 above;

11. That he expressly disclaimed being the inventor of that circuit (see column 3, lines 52-56 of the aforementioned patent); \* \* \*.

\*1036 Mathews has submitted no affidavit under Rule 131. [FN4]

FN4. United States Patent Office Rules of Practice in Patent Cases state:

131. Affidavit of prior invention to overcome cited patent or publication.

(a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photographic or photostatic copies thereof, must accompany and form part of the affidavit or their absence satisfactorily explained. (Emphasis added.)

\*\*1395 The statutory basis for the examiner's rejection reads:

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless--

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, \* \* \*.

Section 102 sets forth enumerated criteria, each of which falls under one of the two specified 'conditions for patentability,' in the section title, namely, 'novelty' and 'loss of right.' The legislative history and prior cases show that subsection (e) is directed to a criterion relating to the requirement for novelty. See in re Land, 368 F.2d 866, 54 CCPA 806 (1966). It necessarily follows that Dewey may not be relied upon to defeat Mathews' application since Dewey's disclosure, in view of the facts established in the record, is not inconsistent with the novelty of Mathews' claimed invention. That is, on the record here, Dewey derived his knowledge from Mathews who is 'the original, first, and sole inventor.'

The Congressional intent behind 35 U.S.C. 102(e) is clear as expressed in both the House and Senate reports [FN5] on the parallel bills which were enacted into the present law:

FN5. H.R.Rep.No. 1923, 82d Cong., 2d Sess. 17 (1952); S.Rep.No. 1979, 82d Cong., 2d Sess. 17 (1952).

Paragraph (e) is new and enacts the rule of (Alexander) Milburn (Co.) v. Davis-Bournonville (Co.), 270 U.S. 390 (46 S.Ct. 324, 70 L.Ed. 651), by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor. (Emphasis added.)

That statement is in the 'Revision Notes' forming part of the Appendix to the reports, and it follows a statement, [FN6] under the 'General Description of the Bill,' which reads:

FN6. H.R.Rep.No. 1923, 82d Cong., 2d Sess. 6-7 (1952); S.Rep.No. 1979, 82d Cong., 2d Sess. 5-6 (1952).

\*1037 Subsection (e) is another well-recognized condition imposed by a decision of the Supreme Court which was not expressed in the existing law (meaning 'statute'); for the purpose of anticipating subsequent inventors, a patent disclosing the subject matter speaks from the filing date of the application disclosing the subject matter.

Thus, the origin of 35 U.S.C. § 102(e) is the 1926 Supreme Court decision in *Alexander Milburn Co. v. Davis-Bournonville Co.*, supra, an infringement suit based on a patent to Whitford granted June 4, 1912, on an application filed March 4, 1911. The validity of the Whitford patent was attacked on the basis of a patent to Clifford granted February 6, 1912, on an application filed in the United States on January 31, 1911, which described but did not claim Whitford's invention. After noting that 'there was no evidence carrying Whitford's invention further back' [FN7] than his \*\*1396 filing date, the Court held that the existence of Clifford's earlier filed United States application containing a disclosure of Whitford's invention indicated that Whitford was not the first inventor. That is the Milburn 'rule' which Congress intended to codify in enacting 35 U.S.C. § 102(e).

FN7. 270 U.S. at 399, 46 S.Ct. at 324.

[1] Consistent with the Milburn 'rule,' we agree that the Dewey patent 'indicates' or is prima facie evidence that Mathews was not the first inventor. But here, unlike Milburn, there is further evidence, uncontroverted by the Patent Office, that Mathews was not only the first inventor but also the only inventor, so far as the record shows. Dewey's affidavit and Mathews' oath accompanying his application are sufficient, we feel, to prove that the relevant disclosure in Dewey was a disclosure of Mathews' invention. The Dewey disclosure relied on, being a disclosure of Mathews' own invention, does not establish lack of novelty of Mathews' claimed invention. Cf. *In re Blout*, 333 F.2d 928, 52 CCPA 751 (1964). As this court said in *In re Land*, supra, at 368 F.2d 879, 54 CCPA 824-825:

When the 102(e) reference patentee got knowledge of the applicant's invention from him, as by being associated with him, \* \* \* and thereafter describes it, he necessarily files the application after the applicant's invention date and the patent as a 'reference' does not evidence that the invention, when made, was already known to others. (Footnote omitted.) Evidence of such a state of facts, whatever its form, must be considered. (Emphasis supplied.)

[2][3] The Patent Office's contention that appellant must comply with Rule 131 is not persuasive since we have already pointed out in *In re Land*, supra, that a Rule 131 affidavit is not the only way of antedating a reference. The solicitor has cited no precedent in support of his position that a reference patent may only be antedated by a Rule 131 affidavit, or even

(Cite as: 56 C.C.P.A. 1033, \*1038 , 408 F.2d 1393, \*\*1396)

referred generally to the authorities previously \*1038 cited by the examiner or board. So far as we have been advised, there is no such precedent to the effect that a Rule 131 affidavit is the only way to overcome a reference cited to evidence lack of novelty. We do not read *Pierce v. Watson*, 107 U.S.App.D.C. 226, 275 F.2d 890 (1960), relied on by the board, as requiring any other conclusion.

The decision of the board is reversed.

\*1034 Reversed.

\*1038 Judge Smith participated in the hearing of this case but died before a decision was reached.

END OF DOCUMENT

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**In re Shaw**

Commissioner of Patents and Trademarks

Opinion dated May 26, 1978

United States Patents Quarterly Headnotes

**PATENTS**

**[1] Commissioner of Patents -- Actions appealable or petitionable (§ 21.05)**

**Pleading and practice in Patent Office -- In general (§ 54.1)**

Petitions requesting Commissioner to review action of Group Director under Patent Rule 181 are treated as requests for review of Group Director's decision by Deputy Assistant Commissioner for Patents inasmuch as authority for deciding petitions involving any ex parte action or requirement in patent application by examiner, which is not subject to appeal, has been delegated to Group Director, who has rendered decision on previous request to review examiner's action.

**PATENTS**

**[2] Abandonment -- Application (§ 10.3)**

Application of applicant who has not filed response to final rejection becomes abandoned.

**PATENTS**

**[3] Abandonment -- Application (§ 10.3)**

Application of applicant who failed to pay base issue fee becomes abandoned.

**PATENTS**

**[4] Applications for patent -- Continuing (§ 15.3)**

**Interference -- Reduction to practice -- Constructive reduction (§ 41.755)**

Patent application filed in U.S. may be entitled to benefit of filing date of prior application filed in U.S., under certain conditions; conditions are specified in 35 U.S.C. 120; statute sets out four conditions, which are that two applications must be by same inventor, previously filed application must disclose invention sought to be patented in manner provided by first paragraph of 35 U.S.C. 112, continuing application must be co-pending with first application or with application similarly entitled to benefit of first application's filing date, and continuing application must contain specific reference to prior application(s) in specification.

**PATENTS**

**[5] Applications for patent -- Continuing (§ 15.3)**

Second application, which is sometimes called "continuing" application, must be application for patent of invention that is also disclosed in first application, which is parent or original disclosure, under Patent Office practice; in particular, continuation-in-part application is described in Manual of Patent Examining Procedure as application filed during lifetime of earlier application by same applicant, repeating some substantial portion or all of earlier application and adding matter not disclosed in that earlier case.

**PATENTS**

**[6] Applications for patent -- In general (§ 15.1)**

**Applications for patent -- Continuing (§ 15.3)**

**Interference -- Reduction to practice -- Constructive reduction (§ 41.755)**

**Pleading and practice in Patent Office -- In general (§ 54.1)**

Examiner, prior to this decision, was not supposed to permit claim for benefit of prior U.S. patent application's filing date unless examiner determines that substantial portion of invention disclosed in second application was included in first application; in comparison, application for patent filed in U.S. may claim benefit of filing date of prior application filed in foreign country without consideration by examiner of whether substantial portion of invention in U.S. application is disclosed in prior filed foreign application; in particular, applicant who wishes to claim priority under 35 U.S.C. 119 must comply only with certain formal requirements within specified time; when claim to priority is made and certified copy of foreign application is received while application is pending before examiner, examiner makes no examination of foreign papers except to see that those papers correspond in date and country to foreign application identified in oath or declaration; subject matter of foreign application is not examined to determine whether applicant is actually entitled to benefit of foreign filing date on basis of its disclosure except when foreign filing date is actually needed, that is, in cases of interferences or when reference is found with effective date between foreign filing date and U.S. filing date.

**PATENTS**

**[7] Applicants for patent -- In general (§ 14.1)**

**Applications for patent -- In general (§ 15.1)**

**Applications for patent -- Continuing (§ 15.3)**

**Interference -- Reduction to practice --  
Constructive reduction (§ 41.755)**

Named inventors in one application are not entitled to claim benefit of prior application that names different inventors, under 35 U.S.C. 120.

**PATENTS**

**[8] Applications for patent -- Continuing (§ 15.3)**

**Applications for patent -- Divisional (§ 15.5)**

**Reissue -- In general (§ 59.1)**

In re Schmidt, 130 USPQ 404, is not applicable in case in which none of "the prior applications" has been converted to reflect instant application's named inventor as sole inventor; patented divisional application's corrections apply only to divisible subject matter claimed in reissue application and do not ipso facto carry over to subject applications whose claimed subject matter differs from that of reissue application.

**PATENTS**

**[9] Applications for patent -- In general (§ 15.1)**

**Applications for patent -- Continuing (§ 15.3)**

**Interference -- Reduction to practice --  
Constructive reduction (§ 41.755)**

**Pleading and practice in Patent Office -- In general  
(§ 54.1)**

Fact that named inventors in instant application differ from the prior applications is sufficient to deny permission to claim benefit of the prior application's filing dates; there is difference in Patent Office practice with regard to amount of examination performed before applicant is permitted to claim benefit of earlier filing date under 35 U.S.C. 119 as compared to 35 U.S.C. 120.

**PATENTS**

**[10] Applications for patent -- Continuing (§ 15.3)**

**Pleading and practice in Patent Office -- In general  
(§ 54.1)**

35 U.S.C. 120's requirement that earlier application disclose second application's invention in manner provided by first paragraph of 35 U.S.C. 112, is examined, generally, in application claiming to be continuation-in-part of earlier application, to extent of determining whether substantial portion or all of earlier application is repeated in second application; however, there is no need to make such determination in continuation-in-part application, unless earlier application's filing date is actually needed, for example, in case of interference or to overcome reference; accordingly, alleged continuation-in-part application should be permitted to claim benefit of

earlier U.S. application's filing date if alleged continuation-in-part application complies with formal requirements of 35 U.S.C. 120 that first application and alleged continuing application were filed "by the same inventor," alleged continuing application was "filed before the patenting or abandonment of or termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application," and alleged continuing application "contains or is amended to contain a specific reference to the earlier filed application."

**PATENTS**

**[11] Amendments to patent application -- New  
matter (§ 13.5)**

**Applications for patent -- Continuing (§ 15.3)**

**Applications for patent -- Divisional (§ 15.5)**

**Patentability -- Anticipation -- In general (§ 51.201)**

No new matter is permitted in continuation or divisional application; filing date of earlier-filed application is always critical date in searching prior art; accordingly, alleged continuation or divisional application that complies with the three formal requirements of 35 U.S.C. 120 is entitled to benefit of filing date of earlier application that discloses invention in manner provided by first paragraph of 35 U.S.C. 112.

**PATENTS**

**[12] Applications for patent -- Continuing (§ 15.3)**

**Commissioner of Patents -- Actions appealable or  
petitionable (§ 21.05)**

**Patentability -- Anticipation -- Carrying date back  
of reference (§ 51.203)**

**Pleading and practice in Patent Office -- In general  
(§ 54.1)**

Examiner has to determine if claimed subject matter in each of two alleged continuing applications was disclosed in "the prior applications" in manner provided by first paragraph of 35 U.S.C. 112 where intervening reference is applied in each of these two applications; review on merits of whether claimed subject matter is disclosed in "the prior applications" is by appeal and not petitionable under Patent Rule 181.

\*287 Applications for patent of Robert F. Shaw, Serial No. 558,332, Robert F. Shaw, Serial No. 558,333, Robert F. Shaw and David E. Stutz, Serial No. 558,335, Robert F. Shaw, Serial No. 558,336, and Robert F. Shaw and Philip E. Eggers, Serial No. 558,338, filed Mar. 14, 1975. On applicants' petitions

to review action of Group Director. Petitions denied.

James W. Geriak, Coe A. Bloomberg, and Lyon & Lyon, all of Los Angeles, Calif., for petitioners.

Feldman, Deputy Assistant Commissioner for Patents.

The above-identified patent applications are before the Commissioner, sua sponte, to further review petitions filed pursuant to 37 CFR 1.181 to review decisions of the Director of Group 330. The decisions of the Director affirmed a requirement of the examiner for applicant(s) to cancel a reference in the specification to prior applications.

A Commissioner's decision rendered March 27, 1978 (March 30, 1978 in S.N. 558, 336) in each of the above-identified applications indicated that "the inventorship of the earlier filed applications and the instant application have properly been changed to Robert F. Shaw as the sole inventor." In fact, the inventors named in \*288 each of prior applications, Serial Nos. 681,737; 63,645; 534,756 have not been changed to Robert F. Shaw as the sole inventor. In view of this error, the decision rendered March 27, 1978 (March 30, 1978 in S.N. 558,336), in each of the above-identified applications, is hereby vacated. [FN1] A new decision follows.

[1] A petition in each of the above-identified applications requests the Commissioner to review the action of the Group Director under the authority of 37 CFR 1.181. Inasmuch as the authority for deciding petitions involving any ex parte action or requirement in a patent application by an examiner, which is not subject to appeal, has been delegated to the Group Director, [FN2] and since the Group Director has rendered a decision on a previous request to review an examiner's action, the petitions are treated as requests for review of a Group Director's decision by the Deputy Assistant Commissioner for Patents. [FN3]

#### Statement of Facts

#### Cases Involved

The cases involved in these petitions and their alleged relationship are shown in Exhibit 1 hereof. These cases are referred herein as follows:

1. Application Serial Nos. 681,737, 63,645 and 534,756 will be referred to as "the prior applications";

2. Application Serial No. 278,684 will be referred to as "the divisional application";

3. Application Serial No. 656,730 will be referred to as "the reissue application"; and

4. Application Serial Nos. 558,332; 558,333; 558,335; 558,336; and 558,338 will be referred to as the "above-identified applications."

The petitions involve only the "above-identified applications."

Serial No. 681,737, now abandoned

Application Serial No. 681,737 was filed November 9, 1967, naming John M. Cage, Robert F. Shaw, and Paul E. Stoft as joint inventors.

This application discloses (Exhibit 2 hereof) a surgical cutting instrument 9 having a cutting edge in the form of an electrically heated element 13 made from material having, ideally, a negative temperature coefficient of resistance. The element may be self-supporting (Fig. 2) or may be disposed along the leading edge of a thin ceramic card 12 in the desired shape of a surgical cutting blade. The element 13 is connected to a power controlling and temperature measuring circuit 11 for energizing the element and for maintaining the temperature of the element constant. Element 13 may consist of a plurality of electrically isolated elements 13 and 13' (Fig. 3), with each of the elements 13 and 13' connected to a separate circuit 11.

[2] The application became abandoned because a response to a final rejection was not filed. 35 U.S.C. 133.

Serial No. 63,645, now abandoned

Application Serial No. 63,645 was filed August 13, 1970, as a streamline continuation [FN4] or application Serial No. 681,737.

The specification, drawing and named inventors are identical with application Serial No. 681,737.

Application Serial No. 63,645 contains the following reference to the prior application:

This is a continuation application of U.S. patent application Serial No. 681,737, \*289 entitled



ELECTRICALLY HEATED SURGICAL CUTTING INSTRUMENT, filed on November 9, 1967, by John M. Cage, Robert F. Shaw, and Paul E. Stoft and now abandoned.

On August 24, 1971, applicants were required to elect a single disclosed species. Applicants were permitted to prosecute the subject matter shown in Figures 1 and 2 (Exhibit 2 hereof).

[3] The application became abandoned, because applicants failed to pay a base issue fee. 35 U.S.C. 151.

Serial No. 278,684, now Patent No. 3,826,263

Application Serial No. 278,684 was filed August 7, 1972, under 37 CFR 1.60 [FN5] as a division of application Serial No. 63,645.

The specification, drawing and named inventors are identical with application Serial Nos. 63,645 and 681,737.

The application matured into Patent No. 3,826,263 on July 30, 1974, with claims readable on the instrument shown in Figure 3 and the circuit shown in Figure 1 (Exhibit 2 hereof).

The patent as corrected on July 24, 1974, contains the following reference to other applications:

This is a divisional application of pending application Ser. No. 63,645, filed Aug. 13, 1970, now abandoned, which is a continuation of application Ser. No. 681,737, filed November 9, 1967, now abandoned.

Serial No. 656,730, pending

Application Serial No. 656, 730 was filed February 9, 1976, in the name of Robert F. Shaw alone, to reissue Patent No. 3,826,263. By the reissue, Shaw seeks to broaden the claims of the patent and to amend the inventorship by removing the names of the two other patentees as inventors.

The specification and drawing are identical with those of Patent No. 3,826,263 and application Serial Nos. 63,645 and 681,737.

Application Serial No. 656,730 contains the following reference to the patent and other applications:

This is a reissue of Patent 3,826,263, which matured from application Serial No. 278,864 filed August 7, 1972 and which is a divisional application of application Serial No. 63,645 filed August 13, 1970, now abandoned, which is a continuation of United States Application Serial No. 681,737 filed November 9, 1967, now abandoned.

An affidavit was submitted February 9, 1976 by John M. Cage, Robert F. Shaw and Paul E. Stoft alleging that all three cooperatively divided an apparatus in which element 13 (Exhibit 1 hereof) is maintained at a constant temperature by heating means formed of a material having a negative temperature coefficient of resistance.

In an Office action being mailed on the same date as this decision, the affidavit filed February 9, 1976 is found insufficient by the examiner on the ground it fails to set forth facts from which to conclude that a misjoinder occurred. [FN6]

Serial No. 534,756, now Patent No. 4,089,336

Application Serial No. 534,756 was filed December 20, 1974, as a continuation application under 37 CFR 1.60 of prior application Serial No. 63,645.

The specification, drawing and named inventors are identical with application Serial Nos. 63,645 and 681,737.

Application Serial No. 534,756 contains the following reference to the prior application:

This application is a continuation of U.S. Patent Application Ser. No. 63,645, filed August 13, 1970, now abandoned, which is a continuation of U.S. Patent Application Ser. No. 681,737, filed November 9, 1967, now abandoned.

The application matured into Patent No. 4,089,336 on May 16, 1978, with claims readable on Figure 1 (Exhibit 2 hereof).

Serial No. 558,332, pending

Application Serial No. 558,332 was filed March 14, 1975, naming Robert F. Shaw as the sole inventor.

Application Serial No. 558,332 discloses a surgical cutting instrument having a cutting edge maintained within a preselected temperature range by conducting

heat from a thermal distributing means that is disposed along the cutting edge.

Application Serial No. 558,332 contains the following reference to prior applications:

This application is a continuation-in-part of U.S. patent Application Serial No. 534,756 filed December 2, 1974, which (sic) is a continuation of U.S. Patent Application Serial No. 63,645 filed August 13, 1970, now abandoned, which \*290 is a continuation of U.S. Patent Application Serial No. 681,737 filed November 9, 1967, now abandoned.

All the claims stand rejected over a single patent issued in 1908. The application is currently awaiting an Examiner's Answer.

Serial No. 558,333, pending

Application Serial No. 558,333 was filed March 14, 1975, naming Robert F. Shaw as the sole inventor.

Application Serial No. 558,333 discloses a surgical cutting instrument having a blade-shaped element whose cutting edge is maintained at a constant operating temperature by dielectric heating of the internal structure of the blade in the region along the cutting edge.

Application Serial No. 558,333 contains the following reference to prior application:

This application is a continuation-in-part of U.S. patent application Ser. No. 534, 756 filed December 2, 1974, which is a continuation of U.S. patent application Ser. No. 63,645 filed August 13, 1970, now abandoned, which is a continuation of U.S. patent application Ser. No. 681,737 filed November 9, 1967, now abandoned.

Some of the claims stand rejected over a patent issued to Robert F. Shaw on October 30, 1973. Applicant has taken an appeal of the rejection. 35 U.S.C. 134. The application is currently awaiting a decision by the Board of Appeals.

Serial No. 558,335, pending

Application Serial No. 558,335 was filed March 14, 1975 naming Robert F. Shaw and David E. Stutz as joint inventors.

Application Serial No. 558,335 discloses a surgical

cutting instrument having a blade whose cutting edge is maintained at a constant operating temperature by conduction of high frequency electrical currents within variable skin depths of a ferromagnetic conductor that is disposed on the blade in the region of the cutting edge.

Application Serial No. 558,335 contains the following reference to prior applications:

This application is a continuation-in-part of U.S. Patent Application Ser. No. 534,756 filed December 2, 1974, which is a continuation of U.S. Patent Application Ser. No. 63,645 filed August 13, 1970, now abandoned, which is a continuation of U.S. Patent Application Ser. No. 681,737 filed November 9, 1967, now abandoned.

An affidavit [FN7] was submitted April 15, 1975, by Robert F. Shaw and David E. Stutz alleging Robert F. Shaw to be the sole inventor. No action on this affidavit has been taken by the examiner.

A number of claims stand rejected under 35 U.S.C. 112. There is no art rejection. The application is currently awaiting an Examiner's Answer. However, a supplemental amendment was filed August 17, 1977 which requires action by the examiner.

Serial No. 558,336, pending

Application Serial No. 558,336 was filed March 14, 1975 naming Robert F. Shaw as the sole inventor.

Application Serial No. 558,336 discloses a surgical cutting instrument having a blade whose cutting edge is electrically heated by induction of circulating currents in the internal structure of the blade near the cutting edge.

Application Serial No. 558,336 contains the following reference to prior applications:

This application is a continuation-in-part of U.S. patent application Serial No. 534,756 filed December 2, 1974, which is a continuation of U.S. patent application Serial No. 63,645 filed August 13, 1970, now abandoned, which is a continuation of U.S. patent application Serial No. \*291 681,737 filed November 9, 1967, now abandoned.

All the claims stand rejected over a patent issued to Robert F. Shaw on October 30, 1973. Applicant has

taken an appeal from the rejection. 35 U.S.C. 134. The application is currently awaiting an Examiner's Answer.

Serial No. 558,338, pending

Application Serial No. 558,338 was filed March 14, 1975, naming Robert F. Shaw and Philip E. Eggers as joint inventors.

Application Serial No. 558,338 discloses a surgical cutting instrument having a blade whose cutting edge is heated to a constant temperature by radiant heating of the blade in the region along the cutting edge.

Application Serial No. 558,338 contains the following reference to prior applications:

This application is a continuation-in-part of U.S. Patent Application Ser. No. 534,756 filed December 2, 1974, which is a continuation of U.S. Patent Application Ser. No. 63,645, filed August 13, 1970, now abandoned, which is a continuation of U.S. Patent Application Ser. No. 681,737 filed November 9, 1967, now abandoned.

An affidavit was submitted April 16, 1975, by Robert F. Shaw and Philip E. Eggers alleging Robert F. Shaw is the sole inventor. No action on the affidavit has been taken by the examiner.

Claim 22 stands rejected under 35 U.S.C. 112. Applicant has taken an appeal. 35 U.S.C. 134. The application is currently awaiting an Examiner's Answer. However, a supplemental amendment was filed August 17 that requires action by the examiner.

#### Background

The file record of each the "above-identified applications" reveals that following an initial Office action, applicant(s) submitted an amendment to insert in the specification a reference to "Related Applications," to claim the benefit of the filing date of the "prior applications." [FN8] Thereupon, the examiner objected to the amendment and required cancellation. The examiner's requirement was adhered to on reconsideration and applicant thereupon filed a petition [FN9] to seek review of the requirement. The Group Director, in denying the petitions, affirmed the requirement by the examiner indicating that:

(1) each of the "above-identified applications" names different inventors from prior application

Serial No. 534,756;

(2) applicant(s) has not sought to change the inventive entity under 35 U.S.C. 116 and 37 CFR 1.45; and

(3) there is no substantial portion of the disclosure in each of the "above-identified applications" common to "the prior applications."

Applicant(s) now seeks review of the decisions of the Group Director.

#### Applicable Law

[4] Under certain conditions, an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in the United States.

The conditions are specified in 35 U.S.C. 120:

35 U.S.C. 120. Benefit of earlier filing date in the United States. An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

The statute sets out four conditions:

1. The two applications must be by the same inventor. [FN10]
2. The previously filed application must disclose the invention sought to be patented in the manner provided by the first paragraph of 35 U.S.C. 112.
3. The continuing application must be co-pending with the first application or with an application similarly entitled to the benefit of the filing date of the first application.
4. The continuing application must contain a specific reference to the prior application(s) in the specification.

#### Office Practice

[5] Under Office practice, the second application (which is sometimes called a "continuing" application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or original disclosure). [FN11] In particular, a continuation-in-part application is described in the M.P.E.P. [FN12] as an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application and adding matter not disclosed in said earlier case (In re Klein, 1930, C.D. 2; 393 O.G. 519).

[6] Prior to this decision, an examiner was not supposed to permit a claim for the benefit of the filing date of a prior U.S. \*292 patent application unless the examiner determines that a substantial portion of the invention disclosed in the second application was included in the first application.

In comparison, an application for patent filed in the United States may claim the benefit of the filing date of a prior application filed in a foreign country [FN13] without consideration by the examiner of whether a substantial portion of the invention in the U.S. application is disclosed in the prior filed foreign application. In particular, an applicant who wishes to claim priority under 35 U.S.C. 119 must comply only with certain formal requirements [FN14] with a specified time. When the claim to priority is made and a certified copy of the foreign application is received while the application is pending before the examiner, the examiner makes no examination of the foreign papers except to see that those papers correspond in date and country to the foreign application identified in the oath or declaration. The subject matter of the foreign application is not examined to determine whether the applicant is actually entitled to the benefit of the foreign filing date on the basis of the disclosure thereof except when the foreign filing date is actually needed, e.g., in cases of interference [FN15] or when a reference is found with an effective date between the date of the foreign filing and the date of the filing in the United States. [FN16]

#### Analysis

##### Same Inventor

[7] "The prior applications," Serial Nos. 681,737, 63,645, and 534,756, were filed in the names of three inventors, John M. Cage, Robert F. Shaw, and Paul E. Stoft. The "above-identified applications," Serial Nos. 558,332, 558,333,

558,335, 558,336, and 558,338, were not filed in the name of the same three inventors. Since the inventors named in "the prior applications" are not the same as the inventor(s) named in "the above-identified applications," petitioners are not entitled to claim the benefit of the prior applications under 35 U.S.C. 120.

[8] The instant petitions allege that each of "the prior applications" have been corrected to reflect that Robert F. Shaw is the sole inventor in each of the cases. The petitions appear to rely on In re Schmidt, 48 CCPA 1140, 243 F.2d 274, 130 USPQ 404 (1961), in support of this position. However, the Schmidt decision is not applicable in this instance. Firstly, none of "the prior applications" have been converted to name Robert F. Shaw as a sole inventor. Secondly, divisional application, Serial No. 278,684, now Patent No. 3,826,263, has not been corrected to name only Robert F. Shaw as a sole inventor, albeit, an affidavit, stating that there was a misjoining of inventors in the divisional application, is of record in the reissue application. However, assuming arguendo that it is determined eventually, in the reissue application, that the divisional application or even "the prior applications," as filed, through error and without deceptive intention included John M. Cage and Paul E. Stoft as joint inventors, the determination will not resolve the difference in named inventors presently existing between "the prior applications" and the "above-identified applications." Specifically, any correction made in the patented divisional application, will apply only to the divisible subject matter claimed in the reissue application. Since the claimed subject matter of each of "the above-identified applications" differs from that of the reissue application, a correction of the patented divisional application does not ipso facto carry over to "the above-identified applications."

##### Same Invention

[9] Ordinarily, nothing more would have to be stated in rendering a decision, since the fact that the named inventors differ in this instance is sufficient to deny permission to claim the benefit of the filing dates of "the prior applications." However, because there is a difference in Office practice with regard to the amount of examination performed before an applicant is permitted to claim the benefit of an earlier filing date under 35 U.S.C. 119 as compared to 35 U.S.C. 120, additional comments are deemed necessary.

[10] Generally, the requirement of 35 U.S.C. 120, that the earlier application disclose the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is examined, [FN17] in an application claiming to be a continuation-in-part of an earlier application, to the extent of determining whether a substantial portion or all of the earlier application is repeated in the second application. However, unless the filing date of the earlier application is \*293 actually needed, e.g., in case of an interference or to overcome a reference, there is no need to make such a determination in a continuation-in-part application. Accordingly, an alleged continuation-in-part application should be permitted to claim benefit of the filing date of an earlier U.S. application if the alleged continuation-in-part application complies with the following formal requirements of 35 U.S.C. 120.

1. The first application and the alleged continuing application were filed "by the same inventor";
2. The alleged continuing application was "filed before the patenting or abandonment of or termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application", and
3. The alleged continuing application "contains or is amended to contain a specific reference to the earlier filed application."

[11] However, with regard to alleged continuation and divisional applications, there is a need to review the substance of the later filed application. No new matter is permitted in a continuation [FN18] or divisional [FN19] application. Moreover, the filing date of the earlier filed application is always the critical date in searching prior art. Accordingly, an alleged continuation or divisional application is entitled to the benefit of the filing date of an earlier application if the alleged continuation or divisional application complies with the three formal requirements of 35 U.S.C. 120 noted above provided the earlier application discloses the invention in the manner provided by the first paragraph of 35 U.S.C. 112.

[12] In this instance, "the above-identified applications" are alleged to be continuation-in-part applications. Assuming arguendo that the inventive entities could be characterized as being the same within the meaning of 35 U.S.C. 120, there would

be no need to strike the reference in each of application Serial Nos. 558,332, 558,335, and 558,338 to "the prior applications." However, with respect to application Serial Nos. 558,333 and 558,336, the examiner would have to determine if the claimed [FN20] subject matter in each of these two applications was disclosed in "the prior applications" in the manner provided by the first paragraph of 35 U.S.C. 112, because an intervening reference was applied in each of these two applications. [FN21]

#### Decision

Since the inventive entities between "the prior applications" and "the above- identified applications" are different, the decision of the Group Director is affirmed. The petitions are denied.

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FN1 Judicial review of the prior decisions was sought in *Shaw v. Parker*, Civil Action No. 78-299-A, filed April 7, 1978 in the United States District Court for the Eastern District of Virginia. An answer has not yet been filed in the Civil Action.

FN2 M.P.E.P. 1002.02(c) [3rd Ed., Rev. 55, Jan., 1978].

FN3 M.P.E.P. 1002.02(b) [3rd Ed., Rev. 55, Jan., 1978].

FN4 See the Commissioner's Notice of February 11, 1966: "Streamlined Continuation Applications. Effective immediately, if the drawings and specification of a new application are to be identical with those of a pending application of the same applicant, and if the claims are to be directed to the same invention as that prosecuted in the pending application, the application papers of the earlier case, excepting the claims but including the drawing, may be used in the new case. A request for the use of such papers must be made and such request will be considered a waiver of the right to further prosecution of the earlier application and will terminate proceedings therein as of the filing date accorded the new application. The filing fee will be that appropriate to all the claims to be included in the new case. The entire file wrapper contents of the earlier application will be included in the file of the new one but the Office actions in the former will not be regarded as actions in the latter and the prosecution of the new application will be conducted in the same manner as if new application papers had

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been filed. A new serial number and filing date will be accorded but the effective filing date will be that of the earlier application." 824 O.G. 1 (March 1, 1966).

FN5 See Also M.P.E.P. 201.06(a) [3rd Ed., Rev. 55, Jan., 1978].

FN6 No views are expressed herein on the merits of the examiner's holding.

FN7 35 U.S.C. 116; 37 CFR 1.45(b).

FN8 See 35 U.S.C. 120.

FN9 37 CFR 1.181.

FN10 The term "same inventor" has been construed in *In re Schmidt*, 48 CCPA 1140, 293 F.2d 274, 130 USPQ 404 (1961), to include a continuing application of a sole inventor derived from an application of joint inventors where a showing was made that the joinder involved error without any deceptive intent (35 U.S.C. 116, 37 CFR 1.45).

FN11 M.P.E.P. Section 201.11, paragraph 1 [3rd Ed., Rev. 55, Jan., 1978].

FN12 M.P.E.P. Section 201.08 [3rd Ed., Rev. 55, Jan., 1978].

FN13 35 U.S.C. 119.

FN14 M.P.E.P. Section 201.14(b) [3rd Ed., Rev. 55, Jan., 1978].

FN15 M.P.E.P. Section 201.15 [3rd Ed., Rev. 55,

Jan., 1978].

FN16 M.P.E.P. Section 201.14 [3rd Ed., Rev. 55, Jan., 1978]; *Kawai v. Metlesics*, 480 F.2d 880, 178 USPQ 158 (CCPA 1973).

FN17 See M.P.E.P. Section 201.08 [3rd Ed., Rev. 55, Jan., 1978].

FN18 See M.P.E.P. Section 201.07 [3rd Ed., Rev. 55, Jan., 1978].

FN19 See M.P.E.P. Section 201.06 [3rd Ed., Jan., 1978].

FN20 *In re Smith*, 590 CCPA 1025, 458 F.2d 1389, 173 USPQ 679 (1972); *Martin v. Johnson*, 59 CCPA 769, 454 F.2d 746, 172 USPQ 391 (1971); *In re Lukach*, 58 CCPA 1233, 443 F.2d 967, 169 USPQ 795 (1971); *In re DiLeone*, 58 CCPA 934, 436 F.2d 1033, 168 USPQ 598 (1971); *In re DiLeone and Lucas*, 58 CCPA 925, 436 F.2d 1404, 168 USPQ 592 (1971); *In re Ahlbrecht*, 58 CCPA 848, 435 F.2d 908, 168 USPQ 293 (1971).

FN21 When necessary, review on the merits of whether the claimed subject matter is disclosed in "the prior applications" is by appeal (35 U.S.C. 134) and not petitionable under 37 CFR 1.181. No views are expressed on the merits. See e.g., the cases cited in n. 20, *supra*.

Comm.Pat. & T.M.

202 U.S.P.Q. 285

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202 U.S.P.Q. 285

United States Court of Appeals,  
Federal Circuit.

**Dr. Raymond G. TRONZO, Plaintiff-Appellee,**  
v.  
**BIOMET, INC., Defendant-Appellant.**

Nos. 97-1117, 97-1177 and 97-1213.

Aug. 28, 1998.  
Rehearing Denied Oct. 19, 1998.

Patentee brought action against competitor, alleging infringement of patent for artificial hip prosthesis, as well as state law claims. Following jury verdict for patentee, the United States District Court for the Southern District of Florida, Daniel T.K. Hurley, J., 950 F.Supp. 1149, denied competitor's motion for judgment as a matter of law, and competitor appealed. The Court of Appeals, Archer, Senior Circuit Judge, held that: (1) parent application did not contain adequate written description of patent at issue so patent was not entitled to parent application's filing date; (2) patent was not infringed under doctrine of equivalents; and (3) neither lost profits nor royalty was proper measure of damages for state law torts of fraud and breach of confidentiality.

Affirmed in part, reversed in part, vacated in part, and remanded.

Pauline Newman, Circuit Judge, concurred in the judgment and filed opinion.

West Headnotes

[1] Federal Courts ⇨765

[1] Federal Courts ⇨776

Court of Appeals reviews a denial of a motion for judgment as a matter of law (JMOL) de novo by reapplying the JMOL standard; thus, Court will reverse a denial of a motion for JMOL only if the jury's factual determinations are not supported by substantial evidence or the legal conclusions implied from the verdict cannot be supported in law by those findings. Fed.Rules Civ.Proc.Rule 50(b), 28 U.S.C.A.

[2] Patents ⇨110

To meet written description requirement so that claim in later-filed patent application is entitled to filing date of earlier application, the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed. 35 U.S.C.A. §§ 112, 120.

[3] Patents ⇨98

A disclosure in a parent application that merely renders a later-claimed invention obvious is not sufficient to meet the written description requirement and thus entitle the later claim to the filing date of the parent application; the disclosure must describe the claimed invention with all its limitations. 35 U.S.C.A. §§ 112, 120.

[4] Patents ⇨314(5)

Whether patent statute's written description requirement has been satisfied is a question of fact. 35 U.S.C.A. § 112.

[5] Patents ⇨110

Parent patent application for artificial hip prosthesis which described only conical cup did not contain sufficient written description of later-filed patent claims, which contained generic limitations as to shape of cup, nor did earlier specification inherently contain disclosure sufficient to meet the written description requirement, and later claims thus were not entitled to filing date of parent application and were invalid as anticipated by intervening prior art. 35 U.S.C.A. §§ 102(b), 112, 120.

[6] Patents ⇨237

An accused device may infringe a patent under the doctrine of equivalents only if it possesses all of the limitations of the relevant claim either literally or equivalently.

[7] Patents ⇨237

Whether an element of the accused device is equivalent to a patent claim limitation depends on whether the substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element; if a theory of

equivalence would vitiate a claim limitation, however, then there can be no infringement under the doctrine of equivalents as a matter of law.

[8] Patents ⇨237

Accused hip prosthesis that contained hemispherical cup did not infringe patent for prosthesis that claimed cup having a "generally conical outer surface," under the doctrine of equivalents, because presence of hemispherical cup would vitiate patent's conical limitation.

[9] Fraud ⇨60

[9] Trusts ⇨103(1)

Under Florida law, neither award of lost profits, in form of constructive trust, nor a reasonable royalty was proper measure of damages for torts of fraud and breach of confidentiality in connection with defendant's alleged promise to pay plaintiff for obtaining patent and defendant's alleged disclosure of patented design, because such awards did not properly reflect plaintiff's actual injury.

[10] Damages ⇨15

In order for an award of damages to be proper under Florida law, there must be some nexus between the damages claimed and the injury incurred.

[11] Damages ⇨15

Under Florida tort law, the damages awarded should place the plaintiff in the position he would have been absent the tortious conduct.

[12] Trusts ⇨103(1)

Under Florida law, to impose a constructive trust, there must generally be an express or implied promise, a transfer of property in reliance thereon, a confidential relationship, and unjust enrichment.

\*1155 James F. Davis, Howrey & Simon, Washington, DC, argued, for plaintiff-appellee. With him on the brief were Jeffrey I. Auerbach and Michael N. Haynes. Of counsel on the brief were Robert S. Hackleman, Connis O. Brown, III, and George S. LeMieux, Gunster, Yoakley, Valdes- Fauli & Stewart, P.A., Fort Lauderdale, FL.

Donald R. Dunner, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., Washington, DC, argued,

for defendant-appellant. With him on the brief were Don O. Burley and Robert L. Burns. Of counsel on the brief was L. Martin Reeder, Jr., Steel Hector & Davis, West Palm Beach, FL.

Before RICH and NEWMAN, Circuit Judges, and ARCHER, Senior Circuit Judge. [FN\*]

FN\* Senior Circuit Judge Glenn L. Archer, Jr. vacated the position of Chief Judge on December 24, 1997.

Opinion for the court filed by Senior Circuit Judge ARCHER. Concurring opinion filed by Circuit Judge NEWMAN.

ARCHER, Senior Circuit Judge.

Biomet, Inc. (Biomet) appeals the judgment of the United States District Court for the Southern District of Florida, 91-CV-8175, holding Biomet liable for infringement of U.S. Patent No. 4,743,262 ('262 patent) and, under Florida law, for breach of a confidential relationship and fraud. The court determined that claims 1, 2, 9, and 10 of the '262 patent were not invalid or unenforceable for inequitable conduct and that Biomet's device infringed claims 1 and 9 literally and claims 1, 2, 9, and 10 under the doctrine of equivalents. Because claims 1 and 9 are not entitled to the filing date of the '262 patent's parent application and are anticipated by intervening prior art, we reverse the \*1156 district court's judgment that these claims are not invalid. Because infringement under the doctrine of equivalents would vitiate the conical limitation in claims 2 and 10, we reverse the district court's judgment of infringement as to these claims. Finally, because substantial evidence supports the jury's verdicts regarding the state law causes of action but the damages awarded thereunder are not commensurate with Dr. Tronzo's (Tronzo) injury, we affirm-in-part and vacate-in-part on those issues, and remand for reconsideration of damages.

## BACKGROUND

The patent and technology in this case relate to artificial hip sockets that include cup implants adapted for insertion into an acetabular, or hip, bone. The claims of the '262 patent at issue read:

1. An acetabular cup prosthesis [sic] comprising a body extending generally longitudinally and terminating into front and rear surfaces, said front surface extending substantially transversely to said



body; and at least one fin for securing said cup to a prepared acetabulum cavity, said fin having a length extending generally longitudinally from said front surface toward said rear surface continuously along said body throughout the entire length of said fin, and said fin being configured so as to extend radially outwardly beyond the perimeter of said front surface and said body so as to engage with the cavity thereby securing said cup.

2. An implant of claim 1, wherein the body has a generally conical outer surface.

9. An acetabular prosthesis consisting essentially of (1) a body extending generally longitudinally and terminating into front and rear surfaces extending substantially transversely to said body; and (2) at least one fin for securing said cup to a prepared acetabulum cavity, said fin having a length extending generally longitudinally from said front surface toward said rear surface continuously along said body throughout the entire length of said fin, and said fin being configured so as to extend radially outwardly beyond the perimeter of said front surface and said body so as to engage with the cavity thereby securing said cup.

10. A prosthesis of claim 9, wherein the body has a generally conical outer surface.

Figures 1 and 3 of the '262 patent illustrate the preferred embodiment of the invention:

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The cup 12 is inserted into a bore or hole 14 in the patient's hip bone 10. The cup has a plurality of longitudinally extended fins (24, 26, and 28) that allow the cup to grip beyond the bore 14 and to lock the prosthesis in place. Once the cup is in place, the fins provide additional resistance to the rotation \*1157 of the cup and allow bony ingrowth into areas not necessarily found in other systems.

Pictured below is the accused Mallory/Head cup, DTX 469A, a hemispherical, finned cup.

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On March 24, 1987, Tronzo filed the application that yielded the '262 patent as a continuation-in-part of an

application filed on June 1, 1984, which issued as U.S. Patent No. 4,681,589 ('589 patent). The '262 patent issued to Tronzo on May 10, 1988. Subsequently, the '262 patent was twice reexamined at the Patent and Trademark Office, resulting in the confirmation of the patentability of the original claims and the addition of claims 9, 10, and 11.

Tronzo sued Biomet on April 25, 1991 for patent infringement and, under Florida law, for breach of a confidential relationship, fraud, and unjust enrichment. By special verdict, the jury found that the patent was entitled to the filing date of the '589 patent's application (the parent application), was not invalid, and was willfully infringed and that Biomet was liable under state law for breach of a confidential relationship, fraud, and unjust enrichment. The jury awarded Tronzo \$3,805,000 for patent infringement; \$4,757,000 in compensatory plus \$15,000,000 in punitive damages for the breach of a confidential relationship; \$7,134,000 in compensatory and \$20,000,000 in punitive damages for fraud; and \$4,750,000 in compensatory damages for unjust enrichment.

In accordance with the jury's findings on the patent issues, including willful infringement, the district court enhanced the damages for patent infringement by fifty percent, resulting in a total award of \$5,707,500. See 35 U.S.C. § 284 (1994) (permitting enhancement of damages up to three times the amount assessed). The district court denied Biomet's motion for judgment as a matter of law (JMOL) on the patent issues. The court further determined that the patent was not unenforceable. Finally, the court granted Biomet's motion for JMOL with respect to the state law claims, dismissing with prejudice the unjust enrichment count and capping the total recovery available to avoid double recovery at \$7,134,000 in compensatory damages and \$20,000,000 in punitive damages.

## DISCUSSION

[1] We review a denial of a motion for JMOL de novo by reapplying the JMOL standard. See *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821, 23 USPQ2d 1426, 1431 (Fed.Cir.1992); see also *Fed. R. Civ. Proc.* 50(b). Thus, we will reverse a denial of a motion for JMOL only if the jury's factual determinations are not supported by substantial evidence or the legal conclusions implied from the verdict cannot be supported in law by those findings. See *Kearns v. Chrysler Corp.*, 32 F.3d 1541,

1547-48, 31 USPQ2d 1746, 1751 (Fed.Cir.1994).

**\*1158 I.**

[2][3][4] For a claim in a later-filed application to be entitled to the filing date of an earlier application under 35 U.S.C. § 120 (1994), the earlier application must comply with the written description requirement of 35 U.S.C. § 112, ¶ 1 (1994). See *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571, 41 USPQ2d 1961, 1965-66 (Fed.Cir.1997). Section 112, paragraph 1 requires that the specification "contain a written description of the invention, and of the manner and process of making and using it." To meet this requirement, the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed.Cir.1991); see also *Hyatt v. Boone*, 146 F.3d 1348, 1354-55, 47 USPQ2d 1128, 1132 (Fed.Cir.1998). A disclosure in a parent application that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. See *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966. Because the issue of whether the written description requirement has been satisfied is a question of fact, we must determine whether substantial evidence supports the jury's verdict that the requirement has been met. See *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed.Cir.1993).

[5] Biomet asserts that claims 1 and 9 of the '262 patent are not entitled to the filing date of the parent application and consequently that intervening prior art anticipates these claims. [FN1] Specifically, Biomet argues that the '589 patent's specification describes only one cup--a conical cup--and thus does not provide sufficient support for claims 1 and 9, which are generic as to the shape of the cup. Thus, Biomet contends that claims 1 and 9 are not entitled to the benefit of the parent application's earlier filing date and are anticipated under 35 U.S.C. § 102(b) (1994) by intervening prior art, including Tronzo's British application which was published on December 4, 1985, more than one year before the filing of the CIP application resulting in the '262 patent, and which was the counterpart to his U.S. application that yielded the '589 patent. [FN2]

[FN1. Biomet concedes that claims 2 and 10 are

adequately supported by the specification of the '589 patent and thus are entitled to the earlier filing date.

[FN2. Biomet also asserts that intervening sales of the accused device should also constitute invalidating, intervening prior art. The district court, however, refused to consider this argument because Biomet had failed to timely raise it. Because Biomet has not demonstrated error in the district court's decision to bar the argument, we also do not reach this contention. See *Austin-Westshore Constr. Co. v. Federated Dep't Stores, Inc.*, 934 F.2d 1217, 1222 (11th Cir.1991); see also *Holmes v. United States*, 85 F.3d 956, 963 (2d Cir.1996).

Tronzo responds that claims 1 and 9 are generic claims as to the shape of the cup and that the '589 patent's specification need only describe a sufficient number of species of cups to support the generic claim. Tronzo asserts that the '589 patent discloses six species of acetabular cup implants, which is sufficient support.

The patentee has conceded that intervening prior art would anticipate claims 1 and 9. [FN3] Thus, the only issue is whether claims 1 and 9 are entitled to the earlier filing date of the parent application. We conclude that substantial evidence does not support the conclusion that the '589 patent specification meets the written description requirement relative to claims 1 and 9 of the '262 patent. Accordingly, these claims are not entitled to the parent application's filing date.

[FN3. Although the basis of the patentee's concession of intervening prior art is not evident from the record, we note that the CIP application disclosed for the first time generically-shaped implant bodies. See '262 Patent, col. 5, ll. 30-31 (disclosing an implant body having "a spherical, conical, trapezoidal, or other suitable outer surface"); *id.* at col. 10, ll. 12-13 (disclosing an implant body having "a semi-circular external shape, or another suitable shape"); see also *Vas-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1115; *In re Lukach*, 442 F.2d 967, 969-70, 169 USPQ 795, 797 (CCPA 1971).

**\*1159** The '589 patent describes the invention as a "trapezoid," a "truncated cone," or a cup of "conical shape." '589 Patent, col. 3, l. 63, col. 4, ll. 22-23. A reading of the specification demonstrates that these labels describe the same cup, and not three different species as asserted by Tronzo. Indeed, contrary to Tronzo's assertions, the '589 patent discloses only two species of cups: an "eccentric cup," which has a top lip shorter than the bottom lip, and a "true" cup, with all sides being equal. See *id.* at col. 5, ll. 3-10.

Moreover, the only reference in the '589 patent's specification to different shapes is a recitation of the prior art. See *id.* at col. 1, ll. 13-24 & 45-49. Instead of suggesting that the '589 patent encompasses additional shapes, the specification specifically distinguishes the prior art as inferior and touts the advantages of the conical shape of the '589 cup. See, e.g., *id.* at col. 3, ll. 63 ("Another extremely important aspect of the present device resides in the configuration of the acetabular cup as a trapezoid or a portion of a truncated cone."). Such statements make clear that the '589 patent discloses only conical shaped cups and nothing broader. The disclosure in the '589 specification, therefore, does not support the later-claimed, generic subject matter in claims 1 and 9 of the '262 patent.

The expert testimony offered at trial does not require a contrary conclusion. Tronzo's expert, Dr. Catanzaro, testified that hemispherical cups are disclosed in the '589 patent's specification, identifying two sections in the '589 patent supposedly making such a disclosure. As recognized by the district court, however, the first section referred to by Dr. Catanzaro as a sufficient disclosure served the narrow purpose of reviewing the prior art and did not describe the invention. See *id.* at col. 1, ll. 13-17. The second section identified by Dr. Catanzaro described "hemispheroidal" position maintaining devices, see *id.* at col. 1, ll. 46-52, but Dr. Catanzaro later conceded that this section did not refer to the shape of the patented cup.

Indeed, the district court recognized that "the written description in the parent '589 does not attempt to identify other, equally functional shapes or talk in terms of a range of shapes...." The court concluded that "the narrow language of the '589 application cannot be said to disclose expressly either the particular hemispherical shape of the '262 claims or the entire genus of cups within which the conical cup of the '589 claims and the hemispherical cup of the '262 claims belong." The district court nevertheless determined that the jury's conclusion could be supported because the '589 patent's specification inherently contained a disclosure sufficient to meet the written description requirement of § 112, ¶ 1.

The only evidence claimed as supporting an inherent disclosure, however, is the testimony of Norman Torchin, another Tronzo expert. Torchin testified that when the inventor stated at column 4, lines 34-38 of the '589 patent that "[a]propos of this, the present concept or invention differs completely from the

blades as shown, for example, in prior U.S. Pat. No. 3,840,904" the inventor meant that "the difference is in the blade as opposed to the structure of the cup, although [the inventor] does prefer the conical cup."

In order for a disclosure to be inherent, however, the missing descriptive matter must necessarily be present in the parent application's specification such that one skilled in the art would recognize such a disclosure. See *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.Cir.1991). There is nothing in the '589 specification to suggest that shapes other than conical are necessarily a part of the disclosure. Indeed, as discussed above, the specification clearly suggests the contrary by asserting advantages of the conical shape over prior art shapes. The rationale of Tronzo's expert claimed to support inherency is not sufficient to support the generic claims in the '262 patent. See *In re MacLean*, 454 F.2d 756, 759, 172 USPQ 494, 497 (CCPA 1972) ("Certainly the single exemplary disclosure of using 93% by weight water in the liquid phase provides no support or description of the recited range 'preponderantly water,' i.e. anything above 50% by weight."). Torchin's testimony does not explain why a broader supporting disclosure is necessarily \*1160 part of the '589 patent. We also agree that the district court properly rejected Torchin's reliance on an incorporation by reference of a prior Tronzo patent as supporting inherency.

Finally, relevant expert testimony of Biomet's witness, Dr. Hill, who testified that in his view as an orthopedic surgeon the '589 patent disclosed only a trapezoidal cup and nothing more is consistent with the express language in the '589 specification.

Accordingly, because the specification of the '589 patent fails to meet the written description necessary to support claims 1 and 9 of the '262 patent, these claims are not entitled to the filing date of the parent application and are invalid as anticipated by the intervening prior art.

## II.

[6][7] The remaining claims at issue, claims 2 and 10, were found to be infringed under the doctrine of equivalents. An accused device may infringe under the doctrine of equivalents only if it possesses all of the limitations of the relevant claim either literally or equivalently. See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 117 S.Ct. 1040, 1054, 137 L.Ed.2d 146 (1997). Whether an element

of the accused device is equivalent to a claim limitation depends on "whether the substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element." *Id.* If a theory of equivalence would vitiate a claim limitation, however, then there can be no infringement under the doctrine of equivalents as a matter of law. See *id.* 117 S.Ct. at 1049, 1053 n. 8.

[8] Biomet argues that infringement of claims 2 and 10 under the doctrine of equivalents by a hemispherical cup would vitiate the limitation requiring that the cup have a "generally conical outer surface." Tronzo responds that substantial evidence supports the jury's conclusion that a hemispherical shape is equivalent to a generally conical shape.

We are convinced that the evidence offered did not adequately establish legal equivalency of the hemispherical shape. While the evidence tended to demonstrate that the shape of the cup was irrelevant to achieving the desired result and that after successful implantation any shape would function essentially the same way, it also indicated that various shapes could produce "forces that might be different." Thus, Tronzo's expert, Dr. Catanzaro, testified that when either a hemispherical cup or trapezoidal cup or any other shape cup is successfully implanted into the body, it functions almost exactly the same way. Now, you can measure forces that might be different in various shapes, but don't forget, once these things are incorporated by the body, the body doesn't look at the shape of the cup, all it is looking at is a ball rotating inside a piece of plastic, because both these things are now part of the body.

(Emphasis added). This testimony as to function and way is merely conclusory on the legal issue to be decided. According to the expert testimony, any shape would be equivalent to the conical limitation of claims 2 and 10. Such a result is impermissible under the all-elements rule of Warner-Jenkinson because it would write the "generally conical outer surface" limitation out of the claims. See 117 S.Ct. at 1053 n. 8. Accordingly, the accused cup cannot infringe claims 2 and 10 under the doctrine of equivalents as a matter of law.

### III.

At trial, the jury additionally found Biomet liable for fraud, and for breach of a confidential relationship, under Florida law. Under the fraud count, Tronzo

asserted that Biomet had promised to pay Tronzo a royalty if he obtained a patent protecting his implant. Tronzo claimed detrimental reliance on this promise in pursuing patent protection and asserted that Biomet never intended to fulfill its promise. Tronzo thus contended that Biomet was liable for fraud. Under the breach of confidentiality count, Tronzo argued that Biomet disclosed his design to others in breach of a confidential relationship between himself and Biomet.

Biomet challenges the jury's verdict regarding liability and damages under these state law claims. As to liability, Biomet asserts \*1161 a litany of challenges to the legal standards applied by the district court and to the adequacy of the evidence supporting the jury's factual determinations. We discern neither legal errors by the district court nor a lack of substantial evidence supporting the jury's verdict regarding liability.

[9] Biomet also challenges the award of either a constructive trust of Biomet's profits or a reasonable royalty to Tronzo under the state law claims because, in Biomet's view, neither is causally related to Tronzo's actual injury. Tronzo responds that a constructive trust is an appropriate remedy under Florida law for either of the state law claims and that there is substantial evidence to support the jury's verdict under either theory.

[10][11] In order for an award of damages to be proper, there must be some nexus between the damages claimed and the injury incurred. See *Rucker v. Garlock, Inc.*, 672 So.2d 100, 102 (Fla. Dist. Ct. App. 1996). Under Florida tort law, the damages awarded should place the plaintiff in the position he would have been absent the tortious conduct. See *Phillips v. Ostrer*, 481 So.2d 1241, 1246 (Fla. Dist. Ct. App. 1985); *Ashland Oil, Inc. v. Pickard*, 269 So.2d 714, 723 (Fla. Dist. Ct. App. 1972); see also *Restatement (Second) of Torts* § 549 cmt. g (1977) ("[T]he purpose of a tort action is to compensate for the loss sustained and to restore the plaintiff to his former position, and not to give him the benefit of any contract he has made with the defendant.").

We conclude that the award of lost profits (as a constructive trust) or a reasonable royalty as damages for the torts asserted is inappropriate because it does not properly reflect Tronzo's actual injury. The district court noted, regarding the fraud claim, that

[w]hile Biomet's argument that a patent is not a detriment has perhaps a superficial appeal, it

neglects the costs to Dr. Tronzo of seeking his patent, defending it on re-examination, and of foregoing opportunities to pursue relationships with other companies or to pursue other means for bringing his acetabular cup to market.

While we agree with this characterization of the injury to Tronzo, such injury is not related to the lost profits damages awarded in this case. Nor do we see how, under the breach of confidentiality claim, Tronzo would have been injured in a way to entitle him to such damages. Instead, the award seems more akin to a remedy for breach of contract instead of either of the alleged torts. See *Ashland*, 269 So.2d at 723 ("[P]laintiffs recovered out-of-pocket expenses ... plus loss of profits on their sales. This would ordinarily be an impermissible double recovery. However, such an award is permissible where plaintiffs pursue an action both for deceit and breach of contract.") (emphasis added).

[12] Moreover, the use of a constructive trust is inappropriate in these circumstances. Generally, to impose a constructive trust, there must be an express or implied promise, a transfer of property in reliance thereon, a confidential relationship, and unjust enrichment. See *Abreu v. Amaro*, 534 So.2d 771, 772 (Fla. Dist. Ct. App. 1988). The purpose of this equitable remedy is both to prevent unjust enrichment and to restore property to its rightful owner. See *id.* Here, the only transfer of "property" that occurred in reliance on Biomet's promise was the transfer of information. The lost profits cannot properly be considered to be the rightful property of Tronzo--he never possessed such money or transferred it to Biomet. Thus, a constructive trust remedy is inappropriate in this case. [FN4]

FN4. Additionally, such a remedy is only appropriate if there are no adequate remedies at law. *Bender v. Centrust Mortgage Corp.*, 51 F.3d 1027, 1030 (11th Cir. 1995) (applying Florida law). In our view, allowing Tronzo to recover only his actual injuries will provide adequate redress.

We also note that upon the record before us there is no evidence to prove any of the costs and injuries incurred by Tronzo, such as the costs of prosecuting the patent and lost business opportunities. Thus, we remand to the district court to determine whether such evidence was presented and, if not, whether in the district court's discretion it would be appropriate to take new evidence in this regard.

#### \*1162 CONCLUSION

We have considered Biomet's other arguments on appeal and find them without merit. We reverse the district court's judgment that claims 1 and 9 are not invalid and that claims 2 and 10 are infringed under the doctrine of equivalents. Given our conclusions regarding invalidity and noninfringement, we do not reach the issues of inequitable conduct or the invalidity of claims 2 and 10. We affirm the district court's judgment of liability under the state law claims but vacate and remand for the district court to determine an appropriate award of damages in accordance with this opinion.

AFFIRMED-IN-PART, REVERSED-IN-PART,  
VACATED-IN-PART AND REMANDED.

PAULINE NEWMAN, Circuit Judge, concurring in the judgment.

I concur in the judgment that claims 1 and 9 of the '262 patent are invalid on the ground of obviousness, in view of the references to Deyerle and McBride. However, the panel majority has erred in its treatment, as "anticipating" prior art under section 102(b), of Dr. Tronzo's own British counterpart of his United States parent application. The disclosure in the British patent is identical to that of the earlier-filed United States parent application; nonetheless, the panel majority treats the British patent as invalidating prior art. However, the patentee is entitled to the benefit of the prior filing of the parent United States application for the subject matter contained therein. Without the improperly relied-upon British counterpart, the rejection based on "anticipation" can not stand.

A continuation-in-part application relates back to its parent's filing date for the common subject matter. Since the intervening publication of the common subject matter is antedated by the United States parent application, the British counterpart is neither an "anticipating" reference nor a statutory bar against the continuation-in-part application. The publication of the British counterpart of Dr. Tronzo's parent application does not deprive him of the benefit of the filing date of the parent application for the subject matter of the parent application.

The contrary holding of the panel majority will have a dramatic adverse effect on continuation-in-part practice. The ruling that the disclosure in an inventor's parent application becomes prior art against

a continuation-in-part application, when it is published before the filing of the continuation-in-part application, is a new and pernicious burden on inventors who seek early entry into the patent system while continuing to investigate the subject of their invention.

The issue of relating back to a parent filing date is different from the issue of constructive reduction to practice of generic claims in the continuation-in-part. There is no issue in this case of determining priority of invention. The issue is whether a patentee can rely on the filing of subject matter in a parent application in order to predate the later publication of that subject matter. According to the court's ruling today, the patentee loses the entire benefit of that earlier filing whenever a continuation-in-part is filed with additional data and broadened claims based in part on that data. That is, the patentee's own prior disclosure now becomes prior art against him. That is new, and incorrect, law. A later publication can not "anticipate" what is already on file; to the contrary, the later publication is removed as a reference by the identical earlier filing in the United

States.

The purpose of the continuation-in-part is to permit an applicant to add new information and data, while retaining the benefit of the original filing date for what was originally filed. Many applicants obtain foreign patents based on the original filing, because of the first-to-file rule in foreign countries and the comity rules of the Paris Convention; some countries publish patents within a few months of their filing. With the court's holding today, such foreign patents are a statutory bar if the continuation-in-part is filed more than a year after the publication of the foreign counterpart. Thus the patentee is deprived of the benefit of the earlier filing in the United States, whenever new matter and broader claims are added by continuation-in-part. This destruction of the continuation-in-part practice is contrary to law and to the public interest. Thus I must, respectfully, \*1163 dissent from the reasoning relied on by the panel majority.

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